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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,375	10/14/2005	Junko Fukuda	265938US6PCT	3837

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314

EXAMINER
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LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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09/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/526,375	<b>Applicant(s)</b> FUKUDA ET AL.	
	<b>Examiner</b> ADAM LEVINE	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3 March 2005, 10 October 2006, 5 February 2008</u> .          | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Election/Restrictions***

1. **Applicant's election without traverse of group IV, claims 16-25, in the reply filed on July 16, 2009, is acknowledged.** Claims 1-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 16, 2009.

### ***Priority***

2. **Should applicant desire to obtain the benefit of Japanese application 2002-264772, filed September 10, 2002, under 35 U.S.C. 119(a)-(d), a certified English translation must be submitted.** 37 CFR 41.154(b) and 41.202(e). Failure to provide a certified translation may result in no benefit being accorded for the non-English application. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Information Disclosure Statement***

3. **The information disclosure statement filed March 3, 2005, fails to comply with 37 CFR 1.98(a)(3)(i)** because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c)

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most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a). With regard to JP 2001-344352, in accord with the parenthetical statement that this document is equivalent to US Pub. No. 2001/49471 (understood as 2001/0049471), examiner has reviewed US Pub. No. 2001/0049471. Unfortunately, it appears that these documents are not in fact equivalent inasmuch as the figures are different and the US Publication cites a different Japanese application as its priority document. (Please note: it appears that machine translations of these documents were submitted with a later IDS. The later submitted IDS has been considered.)

### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Drawings***

5. **The drawings are objected to because lead lines are missing in figures 13-33 and 37.** Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 18-19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject**

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**matter which applicant regards as the invention.** Claim element “analyzing means for analyzing audio information” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

There is no disclosure of the specific structure, material, or act connected with this function. The corresponding structure is required to be more than simply a general purpose computer or microprocessor. *Aristocrat Technologies v. International Game Technology*, 86 USPQ 2d 1235 (Fed. Cir. 2008); *Net MoneyIN Inc. v. VeriSign Inc.*, 88 USPQ 2d 1751 (Fed. Cir. 2008). Disclosing only a general purpose computer as the structure or simply reciting “software” without providing detail about the means to accomplish the function is insufficient. Descriptions of the outcome of the claimed functions is not a description of the structure, i.e. the computer programmed to execute a particular algorithm. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor. The written description of the specification must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm that performs the claimed function. See *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1243. This written description merely discloses a CPU activating an audio recognition program.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim 22 contains the trademark/trade name "Bluetooth." Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of



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goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the general concept of short range wireless transmission and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**7. Claims 24-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 24 is directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter upon an otherwise abstract idea.

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purposes of section 101, a "process" has been given a specialized, limited meaning by the courts. Based on Supreme Court precedent and recent Federal Circuit decisions, a process must (1) be

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ties to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process. See *In re Bilski*, 2008 U.S. App. LEXIS 22479. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

Processes involving mathematical algorithms used in computer technology may be patentable if they are tied to a specific machine or apparatus. Mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application. The Supreme Court has stated that "[p]henomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Benson*, 409 U.S. at 67 (emphasis added). In *Flook* the patentee argued that his claims did not seek to patent an abstract idea (an algorithm) because they were limited to a practical application of that idea—updating "alarm limits" for catalytic chemical conversion of hydrocarbons. 437 U.S. at 586, 589-90. The Court rejected the notion that mere recitation of a practical application of an abstract idea makes it patentable, concluding that "[a] competent draftsman could attach some form of post-solution activity to almost any mathematical formula." *Id.* at 590. Since all other features of the process were well-known, including "the use of computers for 'automatic monitoring-alarming,'" the Court construed the application as "simply provid[ing] a new and presumably better method for calculating alarm limit values." *Id.* at 594-95. The Court held the application unpatentable because "if a claim [as a whole] is directed essentially to a method of

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calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory." 437 U.S. at 595 (quoting *In re Richman*, 563 F.2d 1026, 1030 (CCPA 1977)).

In order to qualify as a statutory process, therefore, claims should positively recite the machine or apparatus to which they are tied, for example by identifying the machine or apparatus that accomplishes the method steps, or they should positively recite the particular article that is being transformed, for example by identifying the material that is being changed to a different state. The mere manipulation of data is not transformation of a particular article. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

In claim 24 the only steps performed by a specific apparatus are the transmission (outputting), receipt and accumulation (gathering) of information. The selecting step is the only significant, limiting step but it recites no tie to a machine or apparatus.

Claim 25 is directed at a computer program not claimed as embodied in a computer-readable medium and as being implemented in a computer apparatus. Data

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structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention that permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer that permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. MPEP 2106 IV B 1 (a).

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Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

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See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**8. Claims 16-25 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLorme (US Patent No. 5,948,040).**

DeLorme teaches all the limitations of claims 16-25. For example, DeLorme teaches an information processing apparatus that selects presentation information to be presented to a user by a first information processing apparatus from among accumulated information received from another information processing apparatus based on user information. DeLorme also discloses mobile users including GPS-linked users accessing the information via wireless communication units. DeLorme further discloses:

- first communication means for receiving user information: which is the information concerning the user, from the other first information processing apparatus (see at least abstract, figs. 2, 7-9; column 2 lines 1-19, column 10 lines 19-58); includes information concerning the longitude and latitude of a location of the user (see at least fig. 8, column 8 lines 22-33, column 21 line 58 – column 22 line 6); audio information spoken by the user acquired by the other first

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information processing apparatus and analyzing means for analyzing the audio information (see at least fig. 7, column 14 lines 53-65, column 15 lines 14-32, column 16 lines 32-59, column 23 line 64 – column 24 line 28); performs communication with the other first information processing apparatus using a Bluetooth technology (see at least abstract, fig. 9, column 10 lines 34-58, column 71 line 60 – column 72 line 43. Please note: see above rejection under 35 USC 112, second paragraph, regarding “Bluetooth” technology. For present purposes, this is understood as any short range radio transmission.);

- second communication means for receiving accumulated information:  
accumulated in another second information processing apparatus from the other second information processing apparatus (see at least column 1 lines 26-47, column 3 lines 53 – column 4 line 14, column 10 lines 34-58, column 25 line 66 – column 26 line 28, column 31 lines 15-41, column 40 lines 16-56); includes article information of articles sold in a shop (see at least column 7 lines 9-53, column 10 line 59 – column 11 line 25, column 14 lines 19-42);
- selecting means for selecting the presentation information: to be presented to the user from among the accumulated information based on the user information and the analysis result in the analyzing means wherein the first communication means transmits the presentation information selected by the selecting means to the first information processing apparatus (see at least abstract, column 1 lines 27-46, column 4 lines 15-42, column 10 lines 34-58, column 15 lines 33-67, column 18 lines 40-57); selects an article expected to be desired by the user

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from among the articles sold in the shop based on the article information of the articles sold in the shop and the article information of the selected article is the presentation information (see at least abstract, column 7 lines 9-53, column 10 line 59 – column 11 line 25, column 14 lines 19-42);

- determining means for determining: whether the user is present in the shop wherein the selecting means selects the article expected to be desired by the user from among the articles sold in the shop where the user is present determined by the determining means (see at least abstract, figs. 1-3, 5, 7-8, column 10 lines 34-58);
- storage means for storing the user information: received by the first communication means and the accumulated information received by the second communication means (see at least fig. 9, column 4 lines 15-42, column 7 line 65 – column 8 line 22);

Pertaining to method claim 24

Rejection of claim 24 is based on the same rationale noted above.

Pertaining to program claim 25

Rejection of claim 25 is based on the same rationale noted above. In addition, DeLorme discloses a program (see at least column 4 lines 43-61, column 35 lines 34-60, column 62 line – column 63 line 32).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
September 12, 2009  
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Examiner, Art Unit 3625